

REMARKS

The present Amendment is filed in connection with an RCE. We are submitting a request for a petition for a three-month extension of time extending the time for filing an RCE from December 10, 2002, up to and including June 10, 2003. However, as a request for a one-month extension of time and the appropriate fee were already filed with the After Final Amendment, we are only required to pay for the three-month extension of time minus the one-month extension of time already paid.

A. Allowable Claims

The Examiner has objected to claims 5-16 as being dependent upon a rejected base claim, but has indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. Applicants previously submitted new claims 27-38 in the Amendment After Final that was not entered by the Examiner. Applicants therefore resubmit new claims 27-38 without any changes to the previously submitted new claims.

Specifically, Applicants have rewritten claims 5 and 11 in independent form as claims 27 and 33, respectively, in accordance with the Examiner's suggestions. Additionally, in accordance with the Examiner's suggestions, new claims 28-32 and 34-38 have been added to depend from claims 27 and 33, respectively. New claims 28-32 are identical to claims 6-10, except for the fact that they depend from claim 27. Similarly, new claims 34-38 are identical to claims 12-16, except for the fact that they depend from claim 33. Accordingly, no new matter has been added. Thus, all of these claims are now believed to be in conditions for allowance.

B. Claims Withdrawn from Consideration

The Examiner has withdrawn from consideration claims 23-26. The Examiner argues that these claims are directed towards an invention that is independent or distinct from the invention as originally claimed. The Examiner therefore constructively elected to examine only the originally filed claims.

Applicants note that in the Amendment After Final, Applicants traversed the provisional election, but requested cancellation of those claims in an effort to place the application in condition for allowance. In view of the fact that a Request for Continued Examination has been filed so that the Examiner has an opportunity to consider the present claim amendments, Applicants respectfully request consideration of claims 23-26.

Applicants traverse the Examiner's restriction and withdrawal of claims 23-26 from consideration. The method claims are drawn to a method of practicing the claimed invention. In other words, the method claims are directed towards a process for applying the surface marking disclosed in claim 17, the main independent claim, to a road surface. Thus, specific reference is made in independent method claim 23 to the surface marking of the present invention, including, without limitation, the application of a surface marking comprised of an adhesive layer directly applied to a road surface when the surface marking is heated, and a wear layer.

Applicants further note that a Request for Continued Examination has been filed. The Examiner had previously indicated that an additional search is necessary to consider the claim amendments proposed by Applicants. As the method claims are drawn to the method of applying the surface marking claimed in the present invention to a road surface, Applicants assert that the Examiner can uncover all relevant art in one search. In this regard, Applicants assert that no additional searching

is necessary to consider the allowability of the method claims.

Thus, Applicants request that the Examiner consider claims 23-26.

C. Rejected Claims 2-4 and 17-22

The Examiner has objected to claims 2-4 and 17-22 as being anticipated by U.S. Patent No. 5,676,488 ("Hedblom"). The Examiner acknowledged the arguments made by Applicants in their response to the First Official Action, but noted that the arguments made by Applicants were moot as they were not positively recited in the claims. Specifically, the Examiner asserted that the claims amended in response to the First Office Action did not positively recite an adhesive-road surface application as discussed by the Applicants in their arguments. Consequently, in response to the Examiner's rejections, Applicants have amended independent claims 17, 19 and 21 to more positively recite that the adhesive layer is directly applied and adhered to the road surface when the surface marking is heated.

Applicants believe that the positive recitation of these characteristics distinguishes over Hedblom. Hedblom teaches the use of heat to cure the first and second topcoat layers, such that each is capable of receiving additional particles. However, in contrast to Applicants' invention, the first cured layer in Hedblom is located on top of a base layer that is directly applied onto the road surface. In other words, the first cured layer is not directly applied or adhered to the road surface, and there is no teaching or suggestion that it is possible to do so.

Because Applicants' newly amended claims clearly recite that the first cured layer (i.e., the adhesive layer) is directly applied and adhered to the road surface when the surface marking is heated, it is believed that the Examiner's rejections are overcome. Thus, Applicants submit that the claims are in condition for allowance.

Application No.: 09/896,795

Docket No.: ALBIHN W 3.0-414

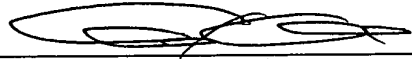
As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: June 10, 2003

Respectfully submitted,

By 
Arnold H. Krumholz
Registration No.: 25,428
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant

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